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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,976	01/21/2000	William J. Baer	STL000014US1	5177
23373	7590	01/13/2005	EXAMINER	
SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037			PHAM, HUNG Q	
			ART UNIT	PAPER NUMBER
			2162	

DATE MAILED: 01/13/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application N .

09/488,976

Applicant(s)

BAER ET AL.

Examiner

HUNG Q PHAM

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 September 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|-----------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

(1) Applicant's amendments of claims 2, 5, 9, 13, 18 and 21 with respect to the rejection under 35 U.S.C § 112, second paragraph, have been fully considered. The rejection of claims 2, 5, 9, 13, 18 and 21 has been withdrawn.

(2) Applicant's arguments with respect to the rejection of claims 25-30 under 35 U.S.C § 112, second paragraph, have been fully considered and are persuasive. The rejection of claims 25-30 has been withdrawn.

(3) Applicant's arguments with respect to the rejection of claims 1, 9 and 17 under 35 U.S.C § 103 have been fully considered but they are not persuasive.

- As argued by applicant at page 11:

However, it is respectfully submitted that the e-book (Corley, et al.: The Legal and Regulatory Environment of Business, 11th Edition, hereinafter "Corley") to which the Examiner refers in the McGraw reference is an e-book that already exists in the McGraw system at the time a user clicks the "Add" button on the screen shown at the top of page 5 of the Office Action. It is respectfully submitted that McGraw neither teaches nor suggests that the "Add" features adds an identifier of user-provided content, as required by claim 1. Rather, the selection of a chapter or section by clicking the "Add" button in McGraw appears only to add to an e-book content already existing in the McGraw system. There is no teaching or suggestion that it would result in the addition of the chapter or selection to Corley, since the respective chapter or section currently exists in the e-book Corley.

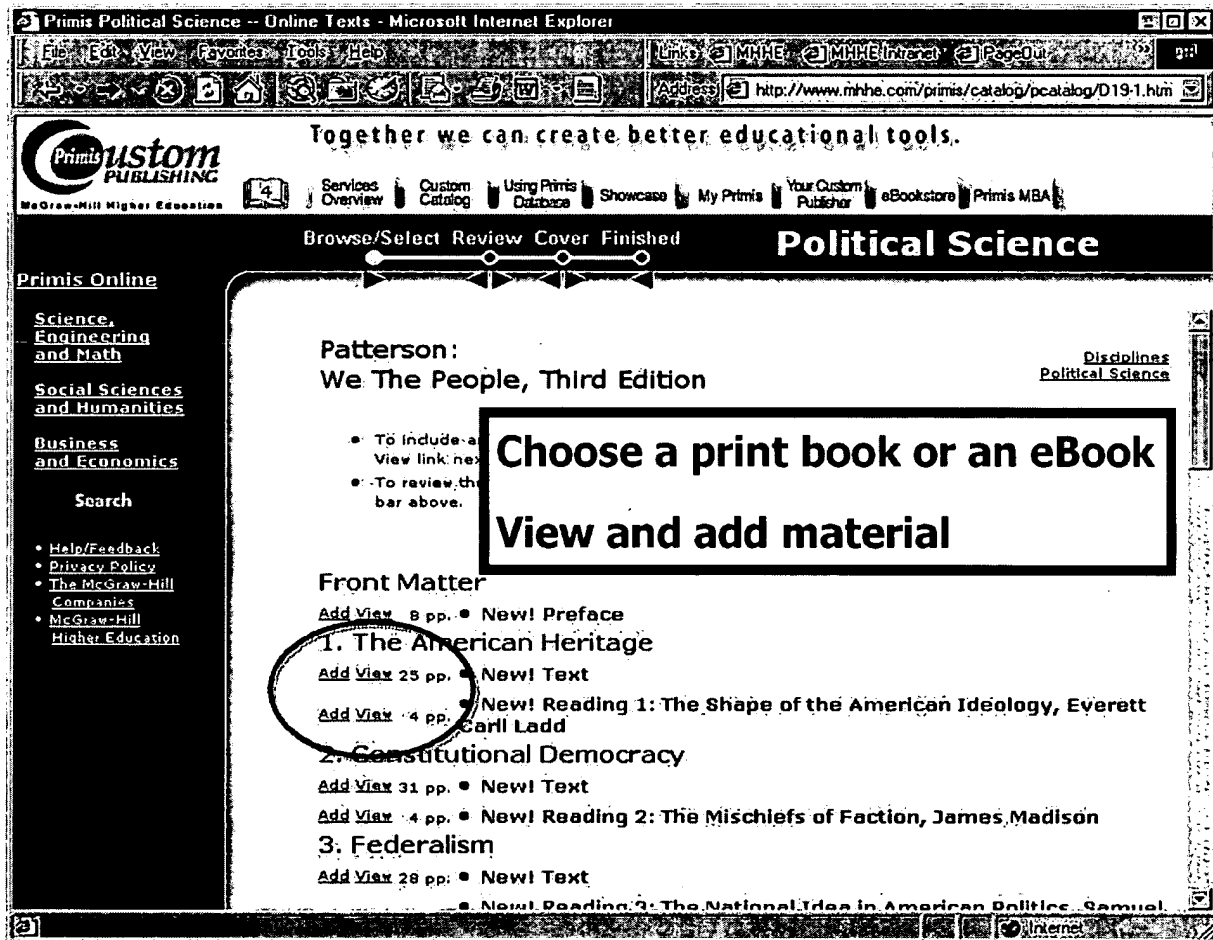
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Examiner respectfully traverses because of the following reasons:

As recited in claims 1, 9 and 17:

adding the identifier of the user-provided content to the list.

As seen at screenshot II and III below:



Screenshot II

Together we can create better educational tools.

Services Overview Custom Catalog Using Primis Database Showcase My Primis Your Custom Publisher eBookstore Primis MBA

Browse/Select/Review/Cover/Finished

Political Science

Review selected items

Your book number: 7908934
Format: 8.5 x 11 [changes](#)
Delivery: eBook [changes](#)

1.5) In sequence boxes, and click any [change](#) button.
and click a [change](#) button.

Review book information and reorder content if necessary

Program/Parent/Item	Digital List \$	Pages
Patterson: We The People, Third Edition		
2. Constitutional Democracy		
Reading 2: The Mischiefs of Faction, James Madison (View)	0.43	4
15. Economic and Environmental Policy		
Reading 15: Long-Term Goals for the Economy, Alice M. Rivlin (View)	0.43	4
10. The News Media		
Reading 10: The Mischief Institution, Thomas E. Patterson (View)	0.43	4
Shively: Comparative Governance		
Theoretical Modules		
The Setting of Power: The State (View)	1.42	13

Note: This product is not available outside the U.S. and Canada.

Click here to delete all 4 items.

US\$ Digital List Price: 2.73 25

Screenshot III

By selecting the *add* button at screenshot II, four pages of *Reading 2: the Mischiefs of Faction, James Madison* as *user-provided content*, which is identified by its *identifier*: *Reading 2: the Mischiefs of Faction, James Madison*, and this *identifier* of these four pages as *user-provided content* is added to the *list* as shown at screenshot III.

Similar to screenshot II, the page of *Corley, et al.: The Legal and Regulatory Environment of Business, 11th Edition* includes a plurality of chapters such as *Chapter 1, Chapter 2...* The content of a chapter are sections such as *New! Business Decision: Calling All Smoker, New!*

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What is Law... The content of each section is the texts content. A section under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button.

When a user activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the content of the chapter will be assigned an identifier that is the chapter name. Referring back to the page of *Corley, et al.: The Legal and Regulatory Environment of Business, 11th Edition*, one page of text *Of New! Business Decision: Calling All Smokers* **as user-provided content is received** by the server when activating the *Add* button, section name *New!*

Business Decision: Calling All Smokers **as an identifier is assigned** to one page of text. The screenshot II above also illustrates the content that is provided by a user to compile his/her own book by using the *Add* button. The screenshot III illustrates a table of content or list of a user own book. The *list is added with the identifier of the user-provided content* by using the *Add* button of the screenshot II.

The user can view four pages of *Reading 2: the Mischiefs of Faction, James Madison* **as user-provided content** by activating the View button, and *Reading 2: the Mischiefs of Faction, James Madison* **as an identifier is assigned** to four pages of text.

- As argued by applicant at page 11 with respect to claims 4, 12 and 20:

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Accordingly, it is respectfully submitted that claims 1, 9 and 17 and their dependent claims are not rendered unpatentable by McGraw. Since claims 4, 12 and 20 recite similar elements, claims 4, 12 and 20 and their dependent claims should be deemed patentable for the same reasons.

Examiner respectfully traverses because claims 4, 12 and 20 recite similar elements with claims 1, 9 and 17. Therefore, claims 4, 12 and 20 are unpatentable for the reasons as discussed above.

- As argued by applicant at page 11 with respect to claims 2, 3, 5, 8, 10, 11, 13, 16, 18, 19, 21 and 24:

Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 should be deemed patentable by virtue of their dependency to independent claims 1, 4, 9, 12, 17 and 20 for the reasons set forth above.

Examiner respectfully traverses because dependent claims 2, 3, 5, 8, 10, 11, 13, 16, 18, 19, 21 and 24, each depends either directly or indirectly from independent claims 1, 4, 9, 12, 17 and 20. Therefore claims 2, 3, 5, 8, 10, 11, 13, 16, 18, 19, 21 and 24 are unpatentable for the reasons as discussed above.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

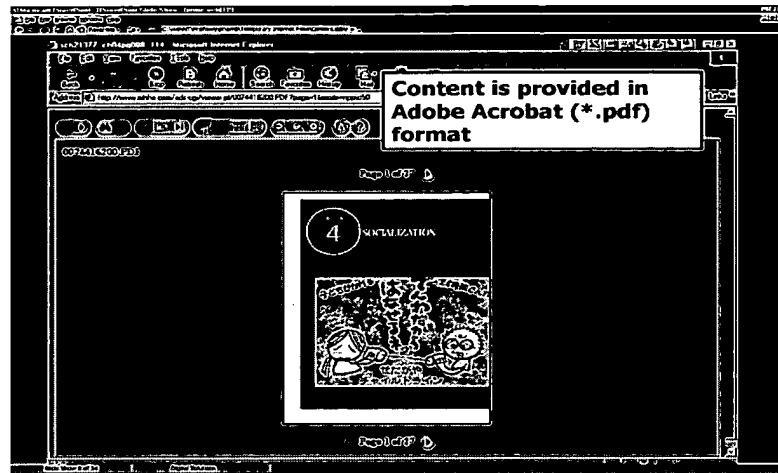
(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

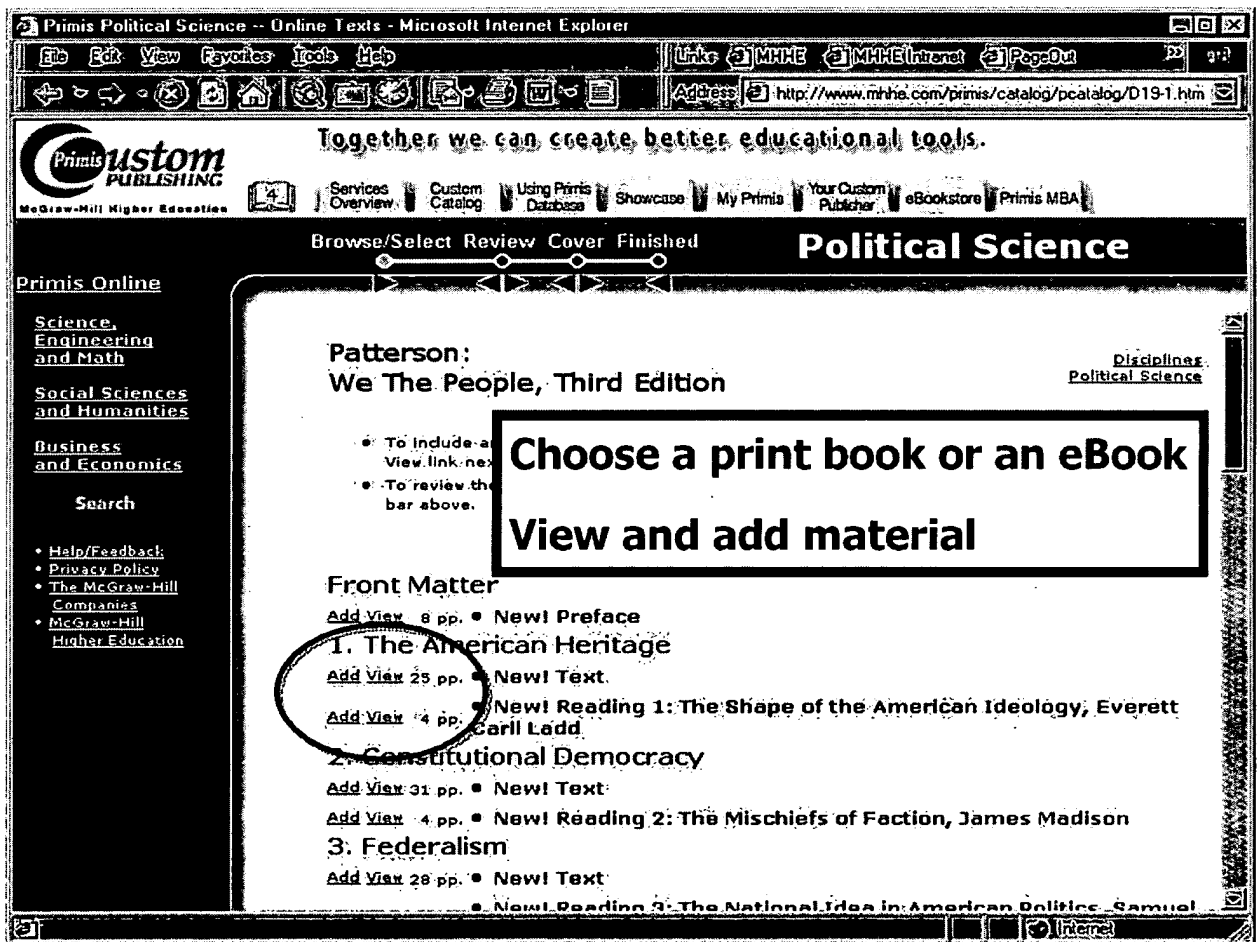
Claims 1, 4, 6-7, 9, 12, 14-15, 17, 20, 22-23 and 25-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw-Hill) [Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> and <http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt>].

Regarding to claims 1, 9 and 17, McGraw-Hill teaches a method and system for building an e-book as *a content object stored as a plurality of content entities*. As shown at screenshot III, the e-book as *content object is defined* by a list of chapters and sections as *content entity identifiers*.

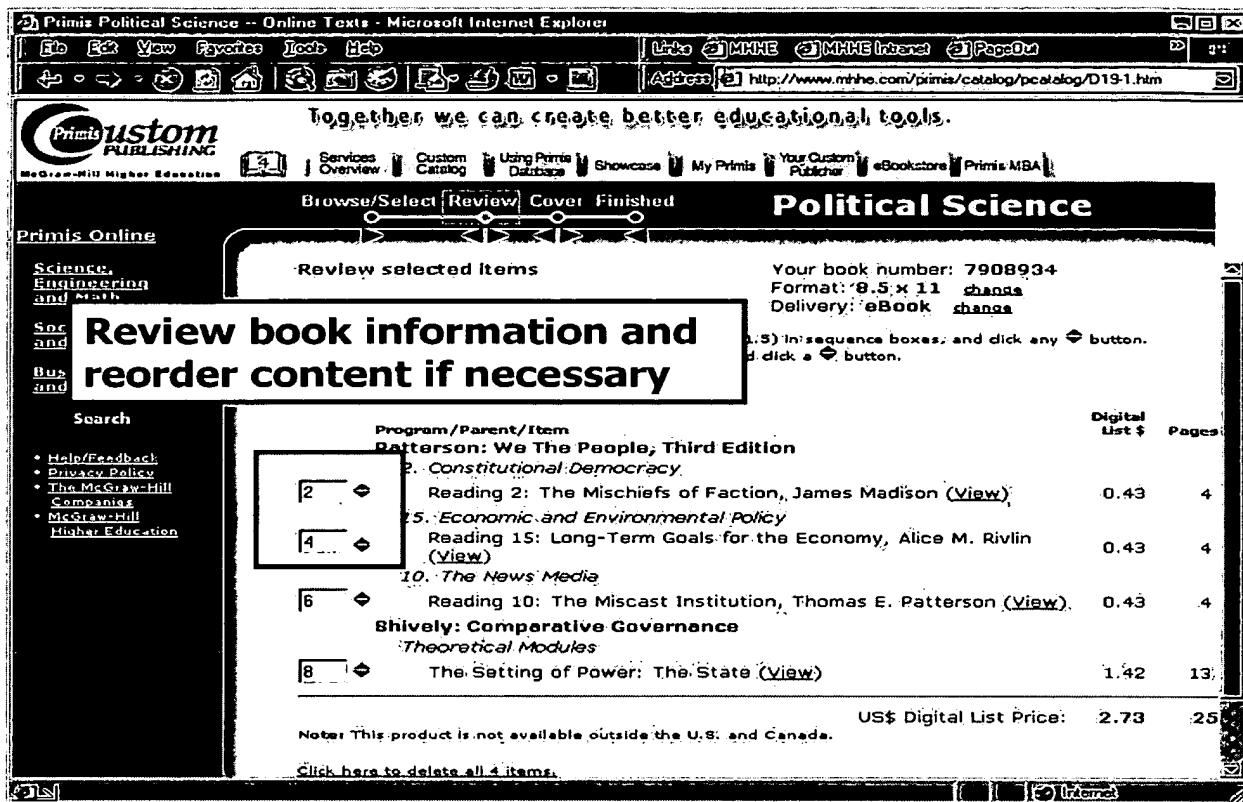
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Screenshot I



Screenshot II



Screenshot III

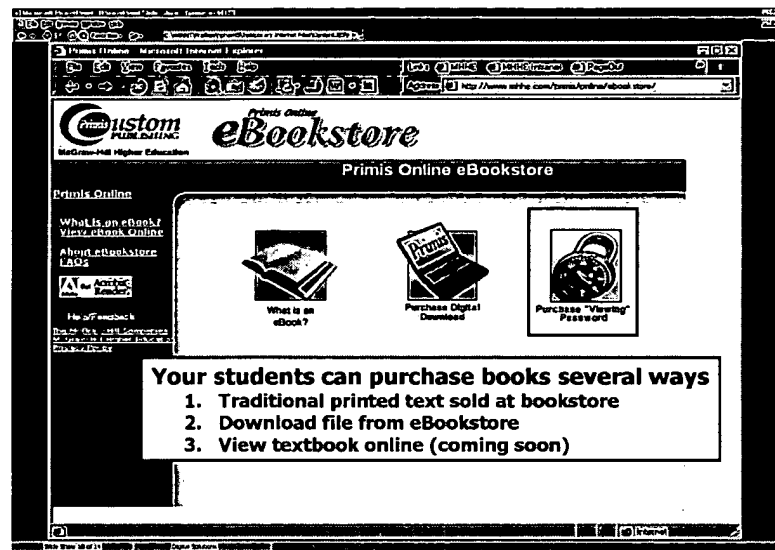
The screenshot II includes a plurality of chapters such as *The American Heritage, Constitutional Democracy...* The content of a chapter are sections such as *New! Reading 2: The Mischiefs of Faction, James Madison...* The content of each section is the texts content indicated by the number of pages of text. A section under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button (Screenshot III, and What is Primis Database Publishing in Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/>). When a user activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the

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content of the chapter will be assigned an identifier that is the chapter name. Referring back to the screenshot II, four pages of text of *New! Reading 2: The Mischiefs of Faction, James Madison* as *user-provided content is received* by the server when activating the *Add* button, section name *New! Reading 2: The Mischiefs of Faction, James Madison* as *an identifier is assigned* to four pages of the text.

The screenshot III illustrates a table of content or list of a user own book. The *list is added* with *New! Reading 2: The Mischiefs of Faction, James Madison* as *the identifier of the* four pages of text as *user-provided content* using the *Add* button of the screenshot III. The user can view four pages of *Reading 2: the Mischiefs of Faction, James Madison* as *user-provided content* by activating the *View* button.

McGraw-Hill does not explicitly teach the step of *storing* the user-provided content and its identifier *in the data repository*. However, as in the Presentation Presenting How To Use Primis Online (Screenshot IV), a user could download the e-book as one way to purchase the book. In order to download the e-book, obviously, the e-book that contains *the user-provided content and its identifier* has to be stored in *a data repository* at the server site.

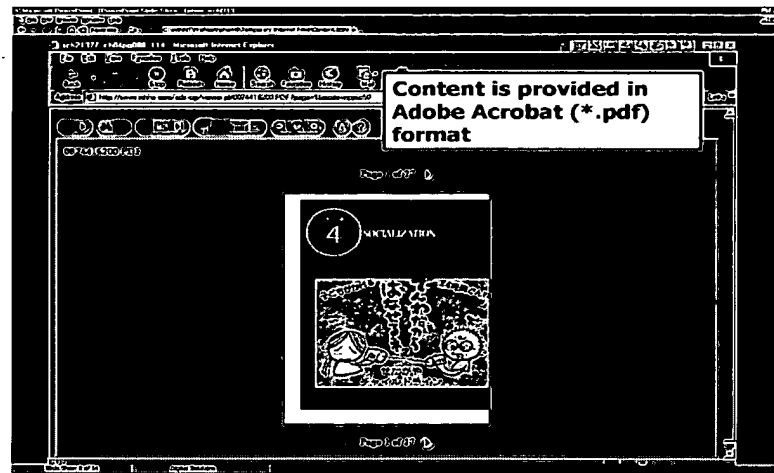


Screenshot IV

Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by storing the e-book in a data repository in order to build and download a customized e-book.

Regarding to claims 4, 12 and 20, McGraw-Hill teaches a method and system for building an e-book as *a content object stored as a plurality of content entities*. As shown at the screenshot III, the e-book as *content object is defined* by a list of chapters and sections as *a hierarchical outline of containers and content entity identifiers*.

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Screenshot I

Primis Political Science -- Online Texts - Microsoft Internet Explorer

Go Edit View Favorites Tools Help

Address http://www.mhhe.com/primis/catalog/pcatalog/D19-1.htm

Together we can create better educational tools.

Primis Publishing McGraw-Hill Higher Education

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Political Science

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Science, Engineering and Math

Soc and Bus and

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- [McGraw-Hill Higher Education](#)

Review selected items

Your book number: 7908934
Format: 8.5 x 11 [change](#)
Delivery: eBook [change](#)

1:5) In sequence boxes, and click any [change](#) button.
d. click a [change](#) button.

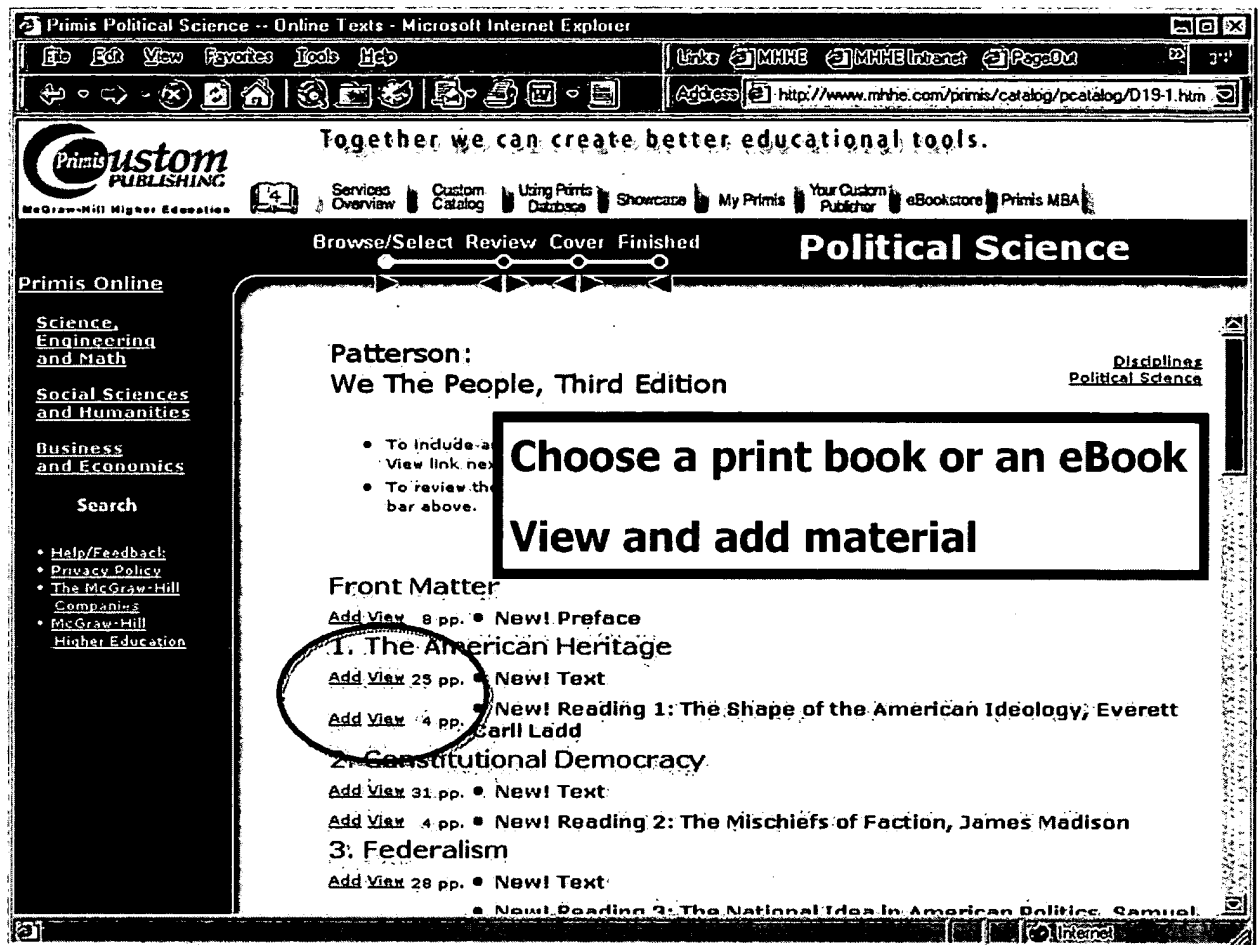
Program/Parent/Item	Digital List \$	Pages
Patterson: We The People, Third Edition		
2: Constitutional Democracy		
Reading 2: The Mischief of Faction, James Madison (View)	0.43	4
15: Economic and Environmental Policy		
Reading 15: Long-Term Goals for the Economy, Alice M. Rivlin (View)	0.43	4
10: The News Media		
Reading 10: The Mischief of Faction, Thomas E. Patterson (View)	0.43	4
Shively: Comparative Governance		
Theoretical Modules		
8: The Setting of Power: The State (View)	1.42	13
US\$ Digital List Price:	2.73	25

Note: This product is not available outside the U.S. and Canada.

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Internet

Screenshot II



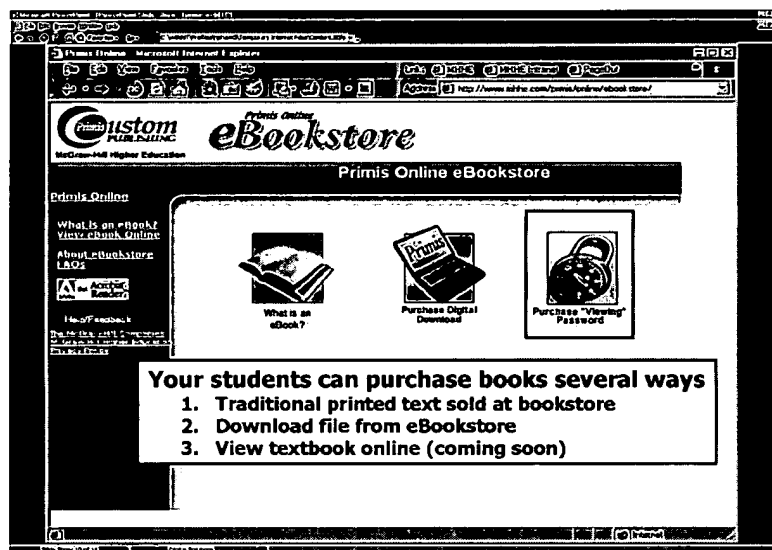
Screenshot III

The screenshot II includes a plurality of chapters such as *The American Heritage*, *Constitutional Democracy*... The content of a chapter are sections such as *New! Reading 2: The Mischiefs of Faction, James Madison*... The content of each section is the texts content indicated by the number of pages of text. A section under a chapter, or the text of a section is an example of the content that will be provided by user in order to compile a user own book by using the *Add* button (Screenshot III, and What is Primis Database Publishing in Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/>). When a user

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activate the *Add* button to add the content of a section into his/her own book, the content of a section will be assigned an identifier that is the section name, and the content of the chapter will be assigned an identifier that is the chapter name. Referring back to the screenshot II, four pages of text of *New! Reading 2: The Mischiefs of Faction, James Madison* as *user-provided content* is received by the server when activating the *Add* button, section name *New! Reading 2: The Mischiefs of Faction, James Madison* as *an identifier* is assigned to four pages of the text. The screenshot III illustrates a table of content or hierarchical *outline* of a user own book. The *outline* is added with *New! Reading 2: The Mischiefs of Faction, James Madison* as *the identifier* of four pages of text as *the user-provided content* using the *Add* button of the screenshot II. The user can view four pages of *Reading 2: the Mischiefs of Faction, James Madison* as *user-provided content* by activating the *View* button.

McGraw-Hill does not explicitly teach the step of *storing* the user-provided content and its identifier *in the data repository*. However, as in the Presentation Presenting How To Use Primis Online (Screenshot IV), a user could download the e-book as one way to purchase the book. In order to download the e-book, obviously, the e-book that contains *the user-provided content and its identifier* has to be stored in *a data repository* at the server site.

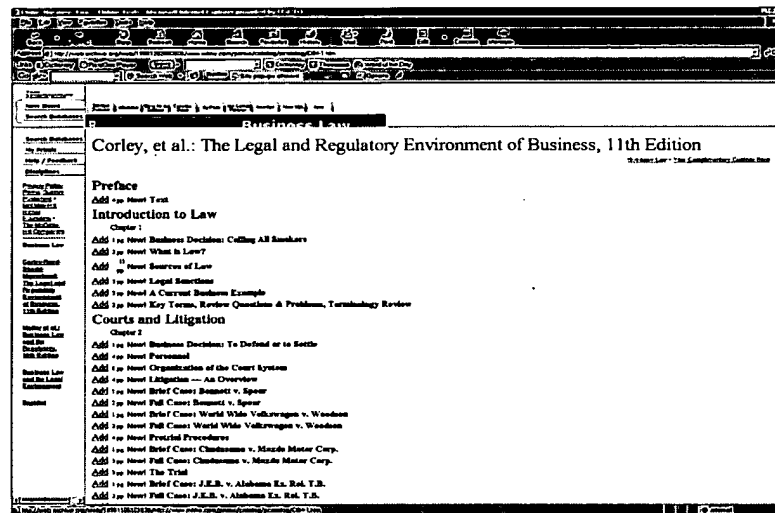


Screenshot IV

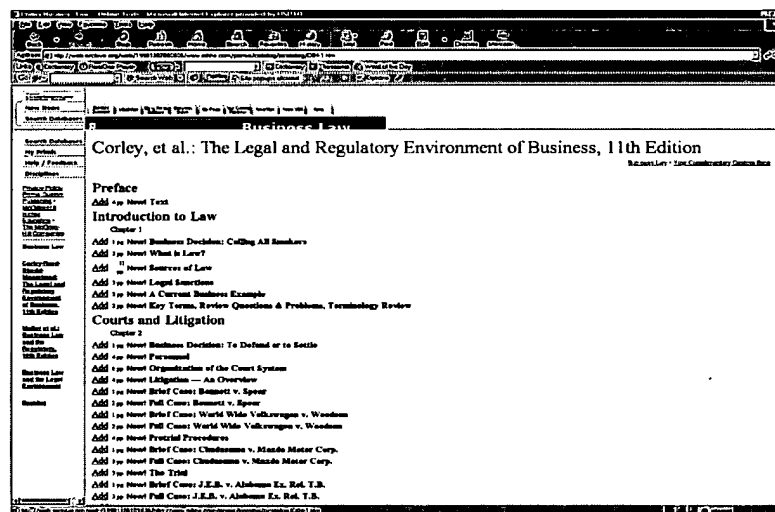
Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by storing the e-book in a data repository in order to build and download a customized e-book.

Regarding to claims 6, 14 and 22, McGraw-Hill teaches all the claimed subject matters as discussed in claims 4, 12 and 20, McGraw-Hill further discloses *the user-provided content comprises a content entity* (McGraw-Hill Primis Custom Publishing).

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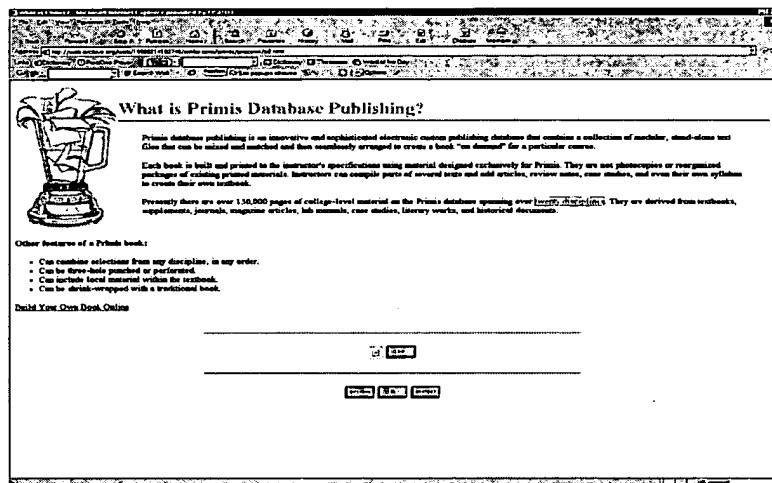


Regarding to claims 7, 15 and 23, McGraw-Hill teaches all the claimed subject matters as discussed in claims 4, 12 and 20, McGraw-Hill further discloses *the user-provided content comprises a container* (McGraw-Hill Primis Custom Publishing).



Regarding to claims 25-30, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 24, 9, 12, 17 and 20 McGraw-Hill further discloses *the received*

user-provided content is not of the content object and wherein the plurality of content entities define the content object as a compilation of related content (McGraw-Hill Primis Custom Publishing).



Claims 2-3, 5, 8, 10-11, 13, 16, 18-19, 21 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over The McGraw-Hill Companies (McGraw-Hill) [Build a Book Online, <http://web.archive.org/web/19980513002459/http://mhhe.com/primis/> and <http://www.mhhe.com/primis/catalog/pcatalog/primisweb.ppt>] in view of Rowe [USP 6,073,148].

Regarding to claims 2, 5, 10, 13, 18 and 21, McGraw-Hill teaches all the claimed subject matters as discussed in claims 1, 4, 9, 12, 17 and 20, but does not explicitly discloses the step of *receiving a user-provided location for inserting the identifier of the user-provided content into the content object, and inserting the identifier into the list at that location*. Rowe teaches a method for creating an optimized PDF file, by creating a list of objects and

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shared objects to organize the objects and place the objects in the optimized file in the same order (Rowe, Col. 10, Line58-Col. 11, Line 13). It would have been obvious for one of ordinary skill in the art at the time the invention was made to modify the McGraw-Hill method by including the technique of organizing the object in the list in order to build a customized e-book.

Regarding to claims 3, 8, 11, 16, 19 and 24, McGraw-Hill and Rowe teaches all the claimed subject matters as discussed in claims 2, 5, 10, 13, 18 and 21, Rowe further discloses the step of *providing a user interface communicating with the data repository, and providing mechanisms for receiving the user-provided content and specification of a desired location through the user interface* (Rowe, Col. 10, Line58-Col. 11, Line 13).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to HUNG Q PHAM whose telephone number is 571-272-4040. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JOHN E BREENE can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Examiner Hung Pham
January 7, 2005

Mohammed Ali
Primary Examiner
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